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Keisuke Horigami

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EXAMINER

STRODER, CARRIE A

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/786,102	Applicant(s) HORIGAMI ET AL.	
	Examiner CARRIE A. STRODER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6, and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is in response to the applicant's communication filed on 09 June 2009, wherein:

Claims 1, 3-6, and 8 are currently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 1 is rejected** under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner has reviewed applicant's disclosure and submits that these added limitations find no support in the specification as currently written, and is, therefore, directed to new matter.

a. "a hardware controller that includes," is not described in the specification as written. Examiner reviewed the specification and did not find this limitation

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recited in the specification. Applicant did not point to any specific area of the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1 and 3-5 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a hardware controller...", which is vague and indefinite. It is unclear what a hardware controller may include, whether a processor, software (which controls the hardware), or something else.

5. **Claim 6 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites that it is a computer program stored on a computer readable medium. It then recites elements of said program. However, the relationship of the program to the recited elements is unclear. Examiner suggests the use of the following language: "A computer program product comprising

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computer instructions that are stored on a computer readable medium and, when executed, cause a computer to perform the following:" for the preamble of claim 6.

6. **Claim 8 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites, "a product information registration management method for causing a computer to execute registration management concerning products, said method comprising:..." Although applicant recites that this is a method claim, by including the language, "for causing a computer to execute registration management concerning products," the claim may be read as a computer product claim.

7. **Claims 6 and 8 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 and 8 recite, "deciding propriety of authorized registration of said product on a basis of the product information acquired at said acquiring product information," which is confusing and improper grammar.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 1-5 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-5 are directed to software, per se, which is not patentable subject matter. SEE MPEP 2106.01. Examiner interprets "hardware controller" to include software which controls hardware.

10. **Claim 8 is rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claim 8, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Although claim 8 states in the preamble that the method causes "a computer to execute...", Examiner gives little weight to the preamble, as it is not positively recited in the claim, which is necessary to tie the machine to the process. Further "a communication line" could be interpreted to be communication between two parties without any physical device involved. Additionally, "as a file" does not necessarily include a machine, either.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3-6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (US 5864755).**

Referring to claim 1:

King teaches

A hardware controller that includes (col. 2, lines 13-19 and Fig. 1; where it is implied that the "wireless telephone system" includes hardware);

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an information acquisition section that acquires product information concerning a product to be registered (col. 2, lines 8-11);

an authorized registration propriety decision section that decides propriety of authorized registration of said product on a basis of the product information acquired by said information acquisition section (col. 1, lines 17-18; the decision section is implied as the phone system must determine whether phones are properly registered or not);

a condition information storage section that stores temporary registration condition information specifying conditions for temporary registration of said product (col. 2, lines 3-13; dialing emergency service is interpreted as a condition);

a temporary registration section that temporarily registers said product if the product is decided to be improper for authorized registration by said authorized registration propriety decision section and if the product information concerning' said product conforms to said temporary registration conditions (col. 2, lines 66-67 and col. 3, lines 1-4);

a historical information storage section that stores historical information concerning temporary registration processing executed by said temporary registration section (col.

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2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time); and

an information updating section that updates said temporary registration condition information on a basis of said historical information stored in said historical information storage section (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time).

Referring to claim 3:

King teaches a wherein said temporary registration condition information includes at least ID information concerning products (col. 2, lines 8-11; "unique identifying number" is interpreted as ID information).

Referring to claim 4:

King teaches wherein said temporary registration condition information includes at least information specifying conditions needed to decide propriety of temporary registration of said product (col. 2, lines 66-67 and col. 3, lines 1-4; wherein the placement of an emergency call is interpreted as the condition).

Referring to claim 5:

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King teaches wherein said product information is a product ID (col. 2, lines 8-11; "unique identifying number" is interpreted as a product ID).

Referring to claim 6:

King teaches

acquiring product information concerning a product to be registered (col. 2, lines 8-11);

deciding propriety of authorized registration of said product on a basis of the product information acquired at said acquiring product information (col. 1, lines 17-18; the decision section is implied as the phone system must determine whether phones are properly registered or not);

storing temporary registration condition information specifying conditions for temporary registration of said product (col. 2, lines 3-13; dialing emergency service is interpreted as a condition);

temporarily registering a product once the product is decided to be improper for authorized registration by said authorized registration propriety decision section and once the product information concerning' said product conforms to said temporary registration conditions (col. 2, lines 66-67 and col. 3, lines 1-4);

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storing historical information concerning temporary registration processing executed by said temporary registration section (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time); and

updating said temporary registration condition information on a basis of said historical information stored at said storing historical information (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time).

Referring to claim 8:

King teaches

acquiring product information concerning a product to be registered through a communication line (col. 2, lines 8-11);

deciding propriety of authorized registration of said product on a basis of the product information acquired at said acquiring product information (col. 1, lines 17-18; the decision section is implied as the phone system must determine whether phones are properly registered or not);

storing, as a file, temporary registration condition information specifying conditions for temporary registration of said product (col. 2, lines 3-13; dialing emergency service is interpreted as a condition);

temporarily registering a product in a database once the product is decided to be improper for authorized registration by said authorized registration propriety decision section and once the product information concerning' said product conforms to said temporary registration conditions (col. 2, lines 66-67 and col. 3, lines 1-4);

storing historical information concerning temporary registration processing executed by said temporary registration section (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time); and

updating said temporary registration condition information on a basis of said historical information stored at said storing historical information (col. 2, lines 28-31; implied since the assignment between the DID and the unique identifying number is terminated after a predetermined time).

Response to Amendment

The amendment filed 05 May 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. "a hardware controller that includes,";

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments filed 09 June 2009 have been fully considered but they are not persuasive.

Applicant argues that the last two elements recited in amended claim 1 are not implied by King. Examiner reminds applicant that it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Examiner further directs applicant to King, col. 2, lines 64-65. The "database" is interpreted as an historical information storage section that stores historical information concerning temporary registration processing executed by said temporary registration section. Further, King "links the PSTN number and IPUI N in said database. This is interpreted as updating said temporary registration condition information on a basis of historical information stored in said historical

information storage section. This applies similarly to claims 6 and 8.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689

/Dennis Ruhl/
Primary Examiner, Art Unit 3689